

REMARKS

Claims 22, 24-26 and 29 are pending in the application, and claims 21, 23, 27, 28 and 30-40 have been withdrawn in accordance with the Examiner's restriction requirement. All of the pending claims stand rejected.

Claim Rejections

The Examiner rejected claims 22, 26 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Lobash *et al.* (U.S. Pat. No. 5,425,217), and rejected claims 24 and 25 as being unpatentable over Lobash in view of Östberg (U.S. Pat. No. 4,416,312). Three criteria must be met to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2142 *et seq.* The Applicant respectfully submits that the prior art of record, regardless of whether it is properly combined, fails to teach or suggest all of the features of the claims, and therefore there is no *prima facie* case of obviousness.

With regard to claim 22, the Examiner alleges that "Lobash...teaches that the air applicator includes a guide plate 18, an open passage 12 having an upstream end and a downstream end opposite the upstream end, and one or more orifices 36 adapted to direct airflow towards the downstream end." Office Action p. 2. However, Lobash fails to show or suggest an "external air applicator" as recited in claim 22. The Examiner further alleges that

Lobash's air applicator is considered to be an external air applicator, since it is located outside the housing of the hopper 32 and the coupon dispenser 54 and connects the hopper 32 to the coupon air applicator 54. In addition, the external air applicator is not defined in the specification of the instant application as an air applicator that does not have a cover. Therefore, Lobash's air applicator can be considered as an external air applicator for the reason stated above.

Office Action, page 4. An “external air applicator” as recited in the present claims is clearly defined in the Specification as having a non-enclosed passageway for receiving and transporting parts. For example, the Specification states, “External air applicators 500, in contrast with internal air applicators 100, *do not have a substantially enclosed passage* 104 for conveying the parts 118. Instead, external air applicators 500 use an *open passage* that is defined, at least on one side, by a guide plate.” Specification, p. 15, ll. 7-10, emphasis added. This claimed feature is shown graphically in the embodiments of Figures 5, 6, 7, 8, 9, 12 and 13, which show a guide plate upon which the parts are conveyed, but does not show a corresponding plate on the opposite side of the air flow to physically contain the parts. Further, the external air applicator is contrasted with an “internal air applicator,” which is defined in the Specification as follows: “Internal air applicators 100 have a substantially enclosed passage 104 (*i.e.*, a generally internal passage having relatively few openings).” Specification, p. 10, ll. 2-4.

Even if the ordinary meaning of the term “external air applicator” were as the Examiner alleges (*i.e.*, an applicator that is located outside the housing of the hopper), Applicant may be his own lexicographer, so long as meaning assigned to the term is “sufficiently clear that any departure from common usage would be understood by a person of experience in the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). The Applicant submits that one of ordinary skill in the art would recognize that an “external air applicator” as recited in the present claims and as described in the Specification, clearly excludes an applicator having an enclosed passage.

In contrast to the claims, Lobash shows a device having what it describes as a “generally closed tunnel.” Lobash col. 2, ll. 30-31. This “tunnel,” which is shown in Lobash Figure 4, consists of a channel 14 having first and second vertical side plates 16 that extend upwards from a center plate 18. *Id.* at col. 3, ll. 27-30. A cover 48 closes off the top of the channel 14 to form “a generally closed envelope or tunnel having an open infeed end and an open outfeed end.” *Id.* at col. 4, ll. 48-52. As such, Lobash fails to

disclose or reasonably suggest an "external air applicator," as recited in claim 22 of the present invention, and thus fails to teach or suggest all of the limitations of claim 22. For at least this reason, there can be no *prima facie* case of obviousness, and the Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 22.

With respect to remaining claims 24-26 and 29, these claims depend from claim 22, and therefore the above rationale applies to traverse the Examiner's rejections as they are set forth in the Office Action. As such, reconsideration and withdrawal of these rejections are respectfully requested.

Conclusion

For at least the above reasons, the Applicant respectfully submits that the application is in condition for allowance, and favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be anything further required to place the application in better condition for allowance, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

Respectfully submitted,  
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